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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/541,457 | 07/06/2005 | Hiroshi Sugitatsu | 273286US0PCT | 8208 |

22850 7590 06/15/2007

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| EXAMINER | |
|---|---|
| MCNELIS, KATHLEEN A | |
| **ART UNIT** | **PAPER NUMBER** |
| 1742 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 06/15/2007 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| **Advisory Action Before the Filing of an Appeal Brief** | **Application No.** 10/541,457 | **Applicant(s)** SUGITATSU ET AL. | |
|---|---|---|---|
| | **Examiner** Kathleen A. McNelis | **Art Unit** 1742 | |

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

THE REPLY FILED 06 June 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1 and 3-11*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 3. NOTE: The amemdment to the specification has not been discussed in the arguments.

It appears that the purpose of the amendment to the specification is to correct an arithmetic error, however examiner does not agree that the change will correct this error.

The change is as follows:

1,089 °C (1,114 °C – [[50°C]] 25 °C = 1,089 °C).

While this would correct the error in the formula (1,114 °C – [[50°C]] 25 °C = 1,089 °C), note that the next line divides 1,089 °C by 78 seconds to arrive at the claimed rate of 13.6 °C/sec. However, the division of 1,089 °C/78 seconds actually results in 13.96 °C. If the 50°C is correct, then 1,114 °C – 50°C = 1,064 °C and 1064 °C/78 seconds results in 13.6 °C. If the 25 °C amendment is correct, then the division of 1,089 °C by 78 seconds to arrive at the claimed rate of 13.6°C/sec is incorrect. It is unclear therefore if the 50 °C value, the 1,089 °C value, the 78 second value or the 13.6 °C/sec or a combination of these values is actually in error.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that Meissner et al. and Perry do not show that the heating rate is a result-effective variable for a chrominum containing material in a particular temperature range.

Examiner's response is that the primary references each disclose reduction of an iron oxide material with carbonaceous material as discussed in the 01/12/2007 Office action pages 3-4. Meissner et al. discloses reduction of an iron oxide material with carbonacoues material as discussed on pp. 4-5 of the 01/12/2007 Office action. Perry's provides evidence that the direct relationship between a higher temperature and faster heating rate are well known. Therefore providing a higher temperature (Meissner et al.) which increases heating rate (Perry's) would have been obvious for no more than the known and expected effect of faster metallization of the iron oxides (Meissner et al.). The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

KM
6/11/2007

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